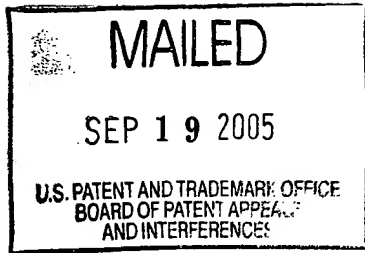


UNITED STATES PATENT AND TRADEMARK OFFICE



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ANTONIO J. COLMENAREZ,  
HUGO J. STRUBBE and SRINIVAS GUTTA

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Application 09/822,121

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on August 26, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that appellants filed an Appeal Brief on November 15, 2004 using the format set forth in 37 CFR § 41.37(c). However, the Appeal Brief does not comply with 37 CFR § 41.37(c).

37 CFR § 41.37 states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

. . . . .

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief filed November 15, 2004:

- 1) "Evidence appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related proceedings appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

A supplemental brief that is in compliance with § 41.37(c) is required. For more information, see the United States Patent and Trademark website [www.uspto.gov](http://www.uspto.gov), and, in particular, the web page entitled "More Information on the Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule" located at the following URL:

[www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

It is also noted that the language of claims 3, 7, 11 and 24 in the Appendix to the Appeal Brief filed November 15, 2004 differs from its last amended version. As required by 37 CFR § 1.192(c)(9) (2004), the Appendix must contain a correct copy of the claims involved in the appeal. Correction is required.

In addition, the Examiner's Answer mailed June 3, 2005 does not comply with the headings set forth in the new rules under 37 CFR § 41.37(c). Correction is required.

Lastly, an examination of the IFW reveals that appellants filed a Reply Brief under 37 CFR § 41.41 on August 3, 2005. On August 24, 2005, the examiner mailed an Office communication which includes a rebuttal of the position set forth in the Reply Brief. Section 41.43 reads as follows:

§ 41.43 Examiner's response to reply brief.

(a)(1) After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.

(2) A supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.

(b) If a supplemental examiner's answer is furnished by the examiner, appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications.

The examiner must follow the guidelines set forth in training material entitled "Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule," located at the following URL:

[www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

It should be noted that in accordance with § 41.43, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a Supplemental Examiner's Answer responding to any

new issue raised in the Reply Brief. A Supplemental Examiner's Answer must be signed by a Technology Center Director or designee and may not include a new ground of rejection. If a Supplemental Examiner's Answer is furnished by the examiner, the appellants are permitted to file another Reply Brief under § 41.41 within two months from the date of the Supplemental Examiner's Answer.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed November 15, 2004 defective;
- 2) for notification to appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37;
- 3) for notification to appellants to submit a corrected Appendix to the Appeal Brief in order to replace the existing defective Appendix;
- 4) for consideration of the supplemental Appeal Brief;
- 5) to vacate the Examiner's Answer mailed June 3, 2005, and issue a revised Examiner's Answer in compliance with the new rules which became effective on September 13, 2004;

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6) to have a complete copy of any subsequent Examiner's Answer scanned into the record;

7) for a proper response to the Reply Brief filed August 3, 2005; and

8) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: \_\_\_\_\_

  
CRAIG R. FEINBERG  
Program and Resource Administrator  
(571) 272-9797

CRF/psb

Philips Intellectual Property & Standards  
P.O. Box 3001  
Briarcliff Manor, NY 10510